

## REMARKS/ARGUMENTS

Claims 1-49 are pending in the application. All claims currently stand rejected. In response to the present Office Action, no claims are amended or cancelled. No new claims are added. Thus, upon entry of this amendment claims 1-49 are pending in the application. No new matter is added.

## RESPONSE TO PROVISIONAL NON-STATUTORY DOUBLE PATENTING REJECTION

Claims 1-49 are provisionally rejected based on the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1, 2, and 6-27 of copending Application Serial No. 09/419,571. In making this provisional rejection, the Examiner stated:

“Claims 1-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 6-27 of copending application Serial No. 09/419,571. Although the conflicting claims are not identical, there are not patentably distinct from each other because the two phase limitation of the instantly claimed gel composition is seen to be inherently met by the claims of the application in that the chemically different ingredients in the copending application would inherently separate and thus form a multiphase system. The solvent ingredient is seen to be rendered obvious by the additional ingredients within the claims of the pending application as well. The solvents are seen to be oils and/or waxes and these oils and waxes are seen to be species of the generically claimed liquids within the claims.

“This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.”

*Office Action dated July 7, 2003 Pages 2-3.*

The Applicants respectfully acknowledge this provisional rejection. If still necessary, the Applicant will file any necessary terminal disclaimers upon indication of otherwise allowable subject matter in the present case.

## RESPONSE TO REJECTIONS UNDER 35 U.S.C. §103(a)

The Examiner has rejected claims 1-49 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,433,068 to Morrison *et al.* (hereafter referred to as “Morrison” or “the Morrison reference”) Specifically the Examiner stated:

“Claims 1-49 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morrison, U.S. Patent 6,433,068.

“This patent discloses gel compositions which can be based on applicant’s instantly claimed ester component and block copolymer. See specifically columns 3 and 4. The instantly claimed solvent is rendered obvious by the disclosure at column 4 lines 40+. While the specific viscosity is not disclosed within this reference, it is seen to be a limitation which is either inherently anticipated or rendered obvious from the disclosure of this reference. This reference teaches the same polymers as well as solvents which fall within the scope of the of the description of the claims. It is reasonable to presume that the same ingredients when used in combination with one another would have the same properties. Applicants have failed to show or allege that such is not the case.”

*Office Action dated July 7, 2003 – Pages 3-4.*

The applicant has considered the rejection in light of the Examiner’s reasoning and respectfully disagrees that *Morrison* renders the claims unpatentable.

#### **The Law Regarding Inherency.**

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex Parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). But the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and would be so recognized by persons of ordinary skill.’” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) And any *prima facie* case obviousness can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claim product. *In re Best at 1255* (emphasis added).

#### **Application of the Law**

*The inherency of the claimed viscosity relationship has not been established because the compositions of the Morrison reference do not necessarily possess a viscosity that is greater than or equal to the viscosity of the gelled component.*

The Examiner has asserted that the compositions of *Morrison* are made from the same components as the claimed invention and will therefore inherently possess the claimed properties. The Applicants respectfully submit that the properties are not inherent.

As discussed above, inherency requires that the compositions necessarily have the recited property. For example, Table 10 of the disclosure shows that the two-phase gel compositions do not necessarily possess a viscosity that is higher than the viscosity of the gelled ester alone. *Page 55, l. 20 – Page 56, l. 4.* Specifically Table 10 shows that the gelled ester alone has a viscosity of about 18,000 cPs. But when the gelled ester includes 30 percent of the hydrophobic, non-polar solvent the viscosity is actually lowered to about 17,000 cPs. Thereafter the viscosity increases to about 288,000 cPs when the solvent is present at about 70 percent. And then when the solvent concentration is about 80 percent, the viscosity of the two-phase gel has decreased to 200,000 cPs. Thus, the viscosity of the two-phase gel is not necessarily greater than the viscosity of the gelled ester composition. Therefore, the recited properties are not necessarily present in the compositions of *Morrison*. Because the Applicant has successfully shown that the recited properties are not inherent, any *prima facie* case of obviousness has been rebutted and the Applicant respectfully requests that the rejection under 35 U.S.C. §103 based on *Morrison* be withdrawn.

### CONCLUSION

The Applicants have addressed all of the Examiner's rejections. In conjunction with the arguments above, the Applicants believe that the application is now in condition for allowance and respectfully request that the Examiner grant such an action. If any questions or issues remain, the resolution of which the Examiner feels will be advanced by a conference with the Applicants' attorney, the Examiner is invited to contact the attorney at the number noted below.

Should there be any additional fees required, please charge such additional fees to Deposit Account 10-0447, reference 42133-00009USP1 (ABDON).

Respectfully submitted,

JENKENS & GILCHRIST  
A Professional Corporation



Robert L. Abdon, Ph.D.  
Reg. No. 50,996

Date: 10/06/2003  
JENKENS & GILCHRIST,  
A Professional Corporation  
1401 McKinney Street, Suite 2700  
Houston, Texas 77010  
Telephone: (713) 951-3338  
Fax: (713) 951-3314